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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/452,188	12/02/1999	SHOICHI YAMAGUCHI	862.3158	9981

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EXAMINER

WON, MICHAEL YOUNG

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 11/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/452,188

Applicant(s)

YAMAGUCHI, SHOICHI

Examiner

Michael Y Won

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-12 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-12 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s).

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 4 and 13-15 have been cancelled. Claims 1, 6, 10, and 18 have been amended. Claims 1-3, 5-12 and 16-18 have been examined and are pending with this action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon (US 5608786 A) in view of and Thompson et al. (US 5,335,276 A).

INDEPENDENT:

As per claim 1, Gordon teaches of a communication apparatus (see col.1 line 66: "messaging system") connected to a communication network (see Fig.1, #4 & #10), said apparatus comprising: destination designating means for designating a destination apparatus (see col.2, lines 25-28 & 44-54); input means for inputting transmission information to be transmitted to the destination apparatus designated by said

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destination designating means without using the communication network (inherent: see Fig.1, all devices used for the purpose of transferring information such as a fax, laptop, telephone, personal computer, and scanner inherently comprise of input means); facsimile communication means for transmitting the transmission information inputted by said input means to a destination apparatus in accordance with facsimile communication specifications (see Fig.1 # 10 & #14 and col.3 lines 41-44); encryption means for encrypting the transmission information inputted by said input means (see col.9, lines 18-33) without using the communication network, wherein the transmission information is encrypted before transmitted through the communication network to maintain confidentiality of the transmission information (see col.9, lines 26-30: "first... telephone legs of the communication"); electronic-mail communication means for transmitting the transmission information inputted by said input means or encrypted by said encryption means to a destination apparatus in accordance with electronic-mail specifications (see col.2 lines 4-6); communication designating means for causing transmission of the transmission information by selecting either said facsimile communication means or said electronic-mail communication means (see col.2, lines 44-54 and col.3 lines 36-38); security designating means for designating whether the transmission information is confidential information or not (see col.9, lines 28-33); and control means (inherent) for controlling said facsimile communication means (see col.36-41), said encryption means (see implicit: col.9, lines 19-33), and said electronic-mail communication means (see col.36-41) such that, if the transmission information has been designated as being confidential by said security designating means, said

facsimile communication means transmits the inputted transmission information to the destination apparatus by facsimile transmission using a private security function which enables the inputted transmission information to be outputted by the destination apparatus when a correct secret number is entered (see col.6, lines 59-66), through the communication network without the encryption of the inputted transmission information by said encryption means (see col.9, line 25-26: "traditional non-encrypted facsimile transmission"), when said facsimile communication means has been designated by said communication designating means (see col.3, lines 30-35), and said electronic-mail communication means sends the encrypted transmission information to the destination apparatus by electronic mail through the communication network, when said electronic-mail communication means has been designated by said communication designating means (see col.2 lines 31-35 and col.2, lines 30-35).

Gordon does not explicitly teach that the security is designated according to an operation of a console, wherein said console is used when confidentiality of the transmission information is to be maintained. Thompson teaches of designated according to an operation of a console, wherein said console is used when confidentiality of the transmission information is to be maintained (see col.14, lines 28-35 and col.18, lines 14-17). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Thompson within the system of Gordon by implementing designating security according to an operation of a console within the communication apparatus because such an implementation gives the control to the user according to his/her preference (see Thompson: see col.2, lines

46-51: "when desired"; col.5, lines 54-58: "desired by the user"; and col.17, lines 45-50: "desired level of security").

As per claim 10, Gordon teaches of a communication method (see col.1 lines 5-13) in a communication apparatus (see col.1 line 66: "messaging system") connected to a communication network (see Fig.1, #4 & #10), said method selectively executing facsimile communication for transmitting transmission information to a destination apparatus in accordance with facsimile communication specification (see Fig.1 # 10 & #14 and col.3 lines 41-44) and electronic-mail communication for transmitting transmission information to a destination apparatus in accordance with electronic mail specifications (see col.2 lines 4-6), and said method comprising the following steps, in a case where the transmission information is to be transmitted to a destination apparatus as confidential information (see col.9, lines 26-33): an apparatus designation step of designating a destination apparatus (see col.2, lines 25-28 & 44-54); an input step of inputting transmission information to be transmitted to the destination apparatus designated by said destination step without using the communication network (inherent: see Fig.1, all devices used for the purpose of transferring information such as a fax, laptop, telephone, personal computer, and scanner inherently comprise of input); security designating step for designating whether the inputted transmission information is confidential information or not (see col.9, lines 28-33); a transmission step of transmitting the transmission information inputted in said input step to the destination apparatus as is by facsimile transmission, using a private security function which enables the inputted transmission information to be outputted by the destination

apparatus when a correct secret number is entered (see col.6, lines 59-66), through the communication network without the encryption of the outputted transmission information (see col.9, line 25-26: "traditional non-encrypted facsimile transmission"), when communication is performed in accordance with facsimile communication and the transmission information has been designated as being confidential information (see col.12, lines 29-48); and encrypting the transmission information inputted in said input step (see col.9, lines 18-33) without using the communication network (see col.9, lines 26-28: "first... telephone legs of the communication"), if the transmission information has been designated as being confidential information and then sending it to the destination apparatus by electronic mail through the communication network to maintain confidentiality of the transmission information, when communication is performed in accordance with electronic-mail communication (see col.12, lines 29-48).

Gordon does not explicitly teach of a console for designating whether the inputted transmission information is confidential or not, wherein the console is used when confidentiality of the transmission information is to be maintained. Thompson teaches of a console for designating whether the inputted transmission information is confidential or not, wherein the console is used when confidentiality of the transmission information is to be maintained (see col.14, lines 28-35 and col.18, lines 14-17). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Thompson within the system of Gordon by implementing designating confidentiality according to an operation of a console within the communication apparatus because such an implementation gives the control to the

user according to his/her preference (see Thompson: see col.2, lines 46-51: "when desired"; col.5, lines 54-58: "desired by the user"; and col.17, lines 45-50: "desired level of security").

As per claim 18, Gordon teaches of a communication apparatus (see col.1 line 66: "messaging system") connected to a communication network (see Fig.1, #4 & #10), said apparatus comprising: destination designating unit adapted to designate a destination apparatus (see col.2, lines 25-28 & 44-54); input unit for adapted to input transmission information to be transmitted to the destination apparatus designated by said destination designating unit without using the communication network (inherent: see Fig.1, all devices used for the purpose of transferring information such as a fax, laptop, telephone, personal computer, and scanner inherently comprise of input means); facsimile communication unit adapted to transmit the transmission information inputted by said input unit to a destination apparatus in accordance with facsimile communication specifications (see Fig.1 # 10 & #14 and col.3 lines 41-44); encryption unit adapted to encrypt the transmission information inputted by said input unit (see col.9, lines 18-33) without using the communication network, wherein the transmission information is encrypted before being transmitted through the communication network to maintain confidentiality of the transmission information (see col.9, lines 26-30: "first... telephone legs of the communication"); electronic-mail communication unit adapted to transmit the transmission information inputted by said input unit or encrypted by said encryption unit to a destination apparatus in accordance with electronic-mail specifications (see col.2 lines 4-6); communication designating unit adapted to cause

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transmission of the transmission information by selecting either said facsimile communication unit or said electronic-mail communication unit (see col.2, lines 44-54 and col.3 lines 36-38); security designating unit adapted to designate whether the transmission information is confidential information or not (see col.9, lines 28-33); and control unit (inherent) adapted to control said facsimile communication unit (see col.36-41), said encryption unit (see implicit: col.9, lines 19-26), and said electronic-mail communication unit (see col.36-41) such that, if the transmission information has been designated as being confidential by said security designating unit, said facsimile communication unit transmits the inputted transmission information to the destination apparatus by facsimile transmission using a private security function which enables the inputted transmission information to be outputted by the destination apparatus when a correct secret number is entered (see col.6, lines 59-66), through the communication network without the encryption of the inputted transmission information by said encryption unit (see col.9, line 25-26: "traditional non-encrypted facsimile transmission"), when said facsimile communication unit has been designated by said communication designating unit (see col.3, lines 30-35), and said electronic-mail communication unit sends the encrypted transmission information to the destination apparatus by electronic mail through the communication network, when said electronic-mail communication unit has been designated by said communication designating unit (see col.2 lines 31-35 and col.2, lines 30-35).

Gordon does not explicitly teach that the security is designated according to an operation of a console, wherein said console is used when confidentiality of the

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transmission information is to be maintained. Thompson teaches of designated according to an operation of a console, wherein said console is used when confidentiality of the transmission information is to be maintained (see col.14, lines 28-35 and col.18, lines 14-17). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Thompson within the system of Gordon by implementing designating security according to an operation of a console within the communication apparatus because such an implementation gives the control to the user according to his/her preference (see Thompson: see col.2, lines 46-51: "when desired"; col.5, lines 54-58: "desired by the user"; and col.17, lines 45-50: "desired level of security").

DEPENDENT:

As per claims 2-3 and 11-12, Gordon further teaches of a computer program product embodying a computer program for implementing functions described in claims 1 and 10, and a computer-readable recording medium storing a computer program for implementing functions described in claims 1 and 10 (see col.6 lines 18-20).

As per claims 4, 5, and 13, Gordon further teaches wherein, if the destination apparatus possesses a private security function, said facsimile communication means checks to determine whether the destination apparatus possesses a private security function by inquiring as to whether the destination apparatus possesses the private security function when a communication path to the destination apparatus is formed and transmits the inputted transmission information by confidential communication utilizing

the private security function, when the transmission information has been designated as being confidential by said security designating means (see col.9 lines 18-28).

As per claims 6, 7, 14, and 15, Gordon further teaches of a computer program product embodying a computer program for implementing functions described in claims 5 and 13 and a computer-readable recording medium storing a computer program for implementing functions described in claims 5 and 13 (see col.6 lines 18-20 and col.10 lines 21-23).

As per claims 8, Gordon further teaches wherein said security designating means makes a determination that the transmission information is confidential when transmission by a confidential communication is designated (see col.6 lines 28-33).

As per claims 9 and 16, Gordon further teaches wherein said input means comprises a document reader and the transmission information, is inputted by reading a document using the document reader (see col.1 lines 5-10).

3. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon (US 5,608,786 A) and Thompson et al. (US 5,335,276 A) further in view of Yamada (US 5,521,719 A). Gordon and Thompson teaches all the limitations of claim 17 including wherein the communication network includes at least a telephone network, but Gordon and Thompson do not teach that the communication network includes a LAN. Yamada teaches wherein the communication network includes at least a telephone network and a LAN (see Fig.9, #117 & #123 and col.4, lines 43-48). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the

teachings of Yamada within the system of Gordon by implementing a LAN network and a PSTN network within the communication apparatus and method because, Gordon teaches that other networks may be employed (see col.10, lines 6-9 and col.), thus it would be obvious to employ Local Area Network since there is a demand for such a network in today's systems.

Response to Arguments

4. Applicant's arguments filed August 13, 2004 have been fully considered but they are not persuasive. Explanations of the reasons are stated below.

In response to the combination of arguments regarding claims 1, 10, and 18, Gordon not only teaches of encryption in the UniPost Access Node but also prior to the transmission to the UniPost Access Node (see col.9, lines 26-31). Clearly Gordon teaches that "additional security can include predetermined encryption of the communication on either the **first** or last telephone legs of the communication", and further gives an example "communication **between a subscriber and UniPost can be encrypted...** if desired". The statement above inherently defines encryption before the data first entered the network. To suggest otherwise is incorrect.

Gordon teaches the element of encryption (sending node) and decryption (receiving node) and that the subscriber can "specify or choose various levels of security for **different messages** or retrieval of different messages" (see col.9, lines 31-

34), wherein the different messages are voice, E-Mail, and facsimile (see col.3, lines 36-40). Therefore, in response to the argument, Gordon clearly "discloses a system of any type that would be capable of ensuring the security of transmission information by encryption for e-mail transmission", voice, and facsimile.

In Column 9, lines 19-33, Gordon teaches of encryption within communication between UniPosts, but further adds that encryption can occur in any "leg of the communication" if desired.

The teachings of Gordon such as "password" for retrieving messages (see col.6, lines 59-66) or means of encryption between a subscriber and UniPost (see col.9, lines 26-31), clearly teaches of a "private security function".

New reference Thompson et al. (US 5,335,276 A) is relied upon to teach the missing element of the claimed language, namely a "console", which Thompson clearly teaches of giving the initiation and control of the functions to the users.

Applicant's arguments with respect to Rasmussen et al. (US 5,222,136 A) have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y Won whose telephone number is 571-272-3993. The examiner can normally be reached on M-Th: 6AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Y Won



November 1, 2004



HOSAIN ALAM
ADVISORY PATENT EXAMINER